

REMARKS

In the Office Action¹, the Examiner took the following actions:

rejected claims 6-8 under 35 U.S.C. § 101 as being directed to non-statutory subject matter;

rejected claims 1 and 3-8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2006/0294238 A1 to Naik et al. ("Naik") in view of U.S. Patent Application Publication 2004/0225711 A1 to Burnett et al. ("Burnett").

Applicants have amended claims 1, 3, 4, and 6. Claims 1 and 3-8 remain pending.

Applicants thank the Examiner for the courtesy extended in the telephone interview with Applicants' representative on February 29, 2008, regarding the withdrawal of the finality of the Office Action and issuance of a supplemental non-final Office Action, as summarized in the Examiner's Interview Summary of March 17, 2008. In accordance with these communications and the Examiner's Interview Summary of March 17, 2008, Applicants understand that the status of the Office Action is now non-final.

I. Regarding the rejection of claims 6-8 under 35 U.S.C. § 101

Regarding the rejection of claims 6-8 under 35 U.S.C. § 101, the Examiner rejected the claims, noting that "according to page 14 lines 5-9 [of the Specification] the

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

embodiment of the invention can be implemented in a propagated signal." (See Office Action at pp. 2-3). Applicants respectfully traverse the rejection.

Page 14, lines 5-8 note that "the invention can be implemented as a computer program product, i.e., a computer program tangibly embodied in an information carrier, e.g., in a node-readable storage device or in a propagated signal" Applicants Specification, page 14, ll. 5-8. Applicants respectfully note that the Specification sets forth that a storage device or a propagated signal can be used, however, claim 6 clearly indicates a storage device, thereby excluding the propagated signal. Furthermore, in an effort to advance prosecution, Applicants have amended claim 6 to recite that the computer program product is "stored in a computer-readable storage device," thereby obviating the Section 101 rejection. Claims 7 and 8 depend from claim 6. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 6-8 under 35 U.S.C. § 101.

II. Regarding the rejection of claims 1 and 3-8 under 35 U.S.C. § 103(a) as being unpatentable over Naik in view of Burnett

Applicants respectfully traverse the Examiner's rejection of claims 1 and 3-8 under 35 U.S.C. § 103(a) as being unpatentable over Naik in view of Burnett. A *prima facie* case of obviousness has not been established with respect to claims 1 and 3-8.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The

mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), (emphasis in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

For example, amended claim 1 recites, among other things:

upon receipt of a command requesting a resource, loading new instructions to modify original instructions residing in a computer system to modify the behavior of the one or more computational resources of the computer system;

logging changes made to the computer system, including modifications made to the original instructions by the new instructions; and

reverting the computer system to an original state including removing modifications made to the original instructions, based on the logged changes, without restarting the computer system.

(emphasis added). The prior art, taken alone or in combination, fail to teach or suggest at least these elements of Applicants' claimed invention.

Naik discloses "controlling the participation and performance management of a distributed set of resources in a grid environment. The control is achieved by forecasting the behavior of a group of shared resources, their availability and quality of their performance in the presence of external policies governing their usage, and deciding the suitability of their participation in a grid computation." (Naik, Abstract).

The Examiner cites to paragraphs [0013], [0024] and [0025] of Naik, and further that "routing of grid client request[s] to the best available grid resources" as paraphrased by the Examiner, discloses "upon receipt of a command, loading new instructions to modify original instructions residing in a computer system" as recited in claim 1. Office Action at p. 4. The Examiner also cites to these paragraphs in the Response to Arguments section on pages 8-9 of the Office Action, however, this section provides no additional clarification. Regardless, this interpretation of Naik is not correct. Neither the cited portion of Naik nor any other portions disclose any aspect of loading new instructions or modifying original instructions, as recited in claim 1.

Paragraph [0024] of Naik discusses:

resources on such systems . . . are to be used for serving grid client requests according to the policies set by owner/user of the computer system. At any given instant, multiple local policies may exist and these may dynamically affect the availability of resources to the grid. Even if enough resources are available from multiple computing system for performing grid computations, the dynamically varying availability conditions make the grid management task challenging.

Furthermore, paragraph [0025] of Naik makes reference to various key components of the Naik system.

However, none of these key components described, nor any part of paragraphs [0013] or [0024], disclose “loading new instructions to modify original instructions residing in a computer system,” as required by claim 1. The fact that Naik has varying availability conditions, and may route grid client requests as alleged by the Examiner, in no way discloses any ability to load new instructions for modifying original instructions in a computer system. Routing requests is not the same as “loading new instructions to modifying original instructions residing in a computer system,” as required by claim 1.

Furthermore, nothing in Naik discloses “logging changes made to the computer system, including modifications made to the original instructions by the new instructions; and reverting the computer system to an original state including removing modifications made to the original instructions, based on the logged changes, without restarting the computer system,” as recited in amended claim 1. As noted above, Naik does not disclose any modifying of original instructions by new instructions. The Examiner cites to paragraph [0032] for disclosing “reverting . . . without restarting the computer system” as recited in claim 1. This is incorrect.

Paragraph [0032] simply notes that “grid clients do not have to know the name or location of the actual resources used. These actions are performed transparently to the grid clients and the grid clients are oblivious to the dynamic changes in the availability of grid resources.” The “dynamic changes” discussed in Naik refer only to the fact that the grid clients of Naik are not aware of associations and disassociations of resources throughout the grid. There is no discussion in Naik of any ability to revert a computer

system "to an original state including removing modifications made to the original instructions, based on the logged changes, without restarting the computer system," as recited in amended claim 1.

Naik thus fails to teach at least "loading new instructions to modify original instructions ... logging changes made to the computer system, including modifications made to the original instructions by the new instructions; and reverting the computer system to an original state including removing modifications made to the original instructions, based on the logged changes, without restarting the computer system," as recited in amended claim 1.

Burnett does not compensate for the deficiencies of Naik. The Examiner states that "Naik does not disclose wherein said plurality of computer system." Office Action at p. 4. The Examiner then alleges that Burnett discloses a plurality of computers systems. Even assuming the Examiner's characterization of Burnett is correct, a point which Applicants do not concede, Burnett does not teach or suggest "loading new instructions to modify original instructions ... logging changes made to the computer system, including modifications made to the original instructions by the new instructions; and reverting the computer system to an original state including removing modifications made to the original instructions, based on the logged changes, without restarting the computer system," as recited in amended claim 1.

In view of the above deficiencies of the cited references, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Office Action has not clearly articulated a reason as to why the claim

would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for claim 1 and the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a).

Regarding the rejection of claim 3, amended claim 3 recites, among other things:

loading a first set of instructions from a location remote from the service in response to the command;

replacing a portion of instructions for the service with the first set of instructions;

logging changes made to the computer, including changes made to the portion of instructions for the service;

executing the service according to the first set of instructions; and

reverting the computer to an original state by removing the logged changes made to the computer.

(emphasis added). The prior art, taken alone or in combination, fail to teach or suggest at least these elements of Applicants' claimed invention.

As discussed above in relation to independent claim 1, the grid clients disclosed by Naik do not have any knowledge of dynamic changes to grid resources, and the system allows dynamic association and disassociation of shared resources. (See Naik, paragraphs 0032 and 0035). However, Naik does not teach or suggest "logging changes made to the computer, including changes made to the portion of instructions for the service . . . reverting the computer to an original state by removing the logged changes made to the computer," as recited in amended claim 3.

Applicants note that the Examiner cites to paragraph [0034] and [0036] of Naik as disclosing "replacing a portion of instructions for the service with the first set of

instructions; and executing the service according to the first set of instructions" as recited in claim 3. However, in the next sentence, the Examiner admits that "Naik does not disclose wherein said replacing a portion of instructions for the service with the first set of instructions" and relied on Burnett for disclosing the required claim element. Office Action at p. 5. Applicants respectfully note that the Examiner is using contradictory statements, and that Naik cannot both teach, and not teach, "replacing a portion of instructions for the service with the first set of instructions" as recited in claim 3, and thus, the Examiner's rejection is improper.

Even assuming the propriety of the Examiner rejection, Burnett does not compensate for the deficiencies of Naik, as Burnett does not teach or suggest "logging changes made to the computer, including changes made to the portion of instructions for the service . . . reverting the computer to an original state by removing the logged changes made to the computer," as recited in amended claim 3.

In view of the above deficiencies of the cited references, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Office Action has not clearly articulated a reason as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for claim 3 and the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a).

Independent claim 6, while of different scope, recites elements similar to those of claim 3 and is thus allowable over Naik and Burnett for at least the same reasons

discussed above in regard to claim 3. Claims 4, 5, 7, and 8 are also allowable at least due to their dependence from claims 3 and 6.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.


If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, the Examiner is invited to call the undersigned at (202) 408-4268.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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